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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/196,524	11/20/1998	PAUL M. JESSOP	3517.1	9232

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EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/02/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

ME19

Office Action Summary

Application No.
09/196,524

Applicant(s)
Jessop et al.

Examiner
Dwayne K. Handy

Art Unit
1743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on May 20, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 10-14 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 10-14 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 10, line 39, applicant recites the step of "removing said transfer member from said second receiving plate and said second plurality of pipette tips." This is unclear.

The Examiner understands the step of removing the transfer member from the plurality of pipette tips, but is confused as to the removal of the transfer member from the receiving plate. How can the transfer member be removed from the second receiving plate when the transfer member is never attached to the receiving plate or otherwise connected?

Inventorship

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaramella et al. Scaramella teaches a pipette tip packaging system that includes a transfer plate (29) for

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transferring the pipette tips (10) contained in holder cards (22) to a holder tray (12). The transfer plate includes bosses (30) in the form of projections from the bottom of the holder card for engaging the pipette tips. Scaramella describes using the device in column 5, lines 3-35. "In order to use the packaging system, all that is necessary is to first remove a tray from the box or take any available empty tray. The alignment plate (29) will be latched to the uppermost pipette holder plate or card (22) in the stack with the bosses (30) engaged in the open upper ends of the pipette tips (10) in that card, as illustrated in Figure 5. The user can simply lift the alignment plate and attached card from the box, and align the pipette tips with the openings (20) in the upper wall (18) of tray (12) before lowering them onto the wall (18) so that the lower ends of the pipette tips extend through the openings (20) and the card (22) rests on the upper wall (18) of the tray as illustrated in Fig. 12. At this point, the user presses down on the top (38) of the plunger (36), as illustrated in Figure 6, so that the bosses or projections (42/46) are retracted into post (34) at the same time lifting the alignment plate (29) upwardly away from card (22) and pulling post (34) out through opening (28) leaving the pipette tips ready for use.

"The alignment plate (29) is then returned to the box and lowered onto the next uppermost card (22) in the stack, pressing down on the plunger (36) so that projections (46) are retracted to enable the post (34) to be inserted through opening (28) and the bosses (30) to engage in the upper ends of the pipette tips to hold them upright. The plunger is then released so the projections spring back outwardly to engage beneath card (22) as illustrated in Fig 5., holding

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the card ready for refilling the tray when necessary. Thus a pipette tip holder can be repeatedly loaded with pipette tips quickly and easily.”

This discussion of steps in Scaramella shows every element of claim 10 except for the step of “grasping both said transfer member and said receiving plate with the thumb and forefinger of said user and removing said transfer member, said second receiving plate and said second plurality of pipette tips from said container”. The first paragraph (lines 5-21) recites the steps of placing the plate with the pipettes onto the holding tray, the second paragraph recites the steps of removing the card (22) with the pipettes from its provided container. The Examiner suggests that logic dictates that a card (22) would have to be removed from the container before it could be placed onto the holding tray. This would allow for the proper arrangement of steps. Also, Figure 12 shows a holding tray with a receiving plate already in place on the holding tray (12). As to the limitations in claims 13 and 14, Figure 9 shows a container with stacked cards for holding pipettes and the reference recites “repeatedly loaded pipette tips”. It would have been obvious to continue repeating the loading and unloading steps as needed to retrieve pipettes held in cards in the stack.

As for the limitation cited above from claim 10 as not taught by Scaramella, the Examiner contends that this step would be obvious even though applicant indicates that to grasp both the transfer member and receiving plate a user’s hand is required. Scaramella provides an extra element for engaging the receiving plate/holder card when lifting the transfer member.

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Response to Arguments

7. The Examiner would now like to discuss this issue in light of applicant's previous arguments in the case. The Examiner understands that applicant has provided claims in which the transfer member DOES NOT contain the post element (34) of Scaramella (lines 16-20 of claim 10), but the Examiner points out that the claim contains the open language of "comprising" and thus would allow for use of a transfer member with additional elements beyond those claimed by applicant. This is also relevant in considering the use of the post from Scaramella in latching/connecting to the receiving plate and lifting the receiving plate out of the container. There is nothing in the claim as written that excludes the use of additional elements on the device of Scaramella. As such, and recognizing that the post element of (34) also performs the function of grabbing and lifting the receiving plate, the Examiner contends that grasping the transfer plate of Scaramella after the latch is in place (again, col. 5, lines 3-20) and positioning the transfer member over the holding tray would lift indeed result in the positioning of the receiving plate and pipette tips over the holding tray. Therefore, claims 10-14 are also rejected.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211. The examiner can normally be reached on Monday-Friday from 7:30 to 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on (703)-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703)-772-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

dkh

June 28, 2002